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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,712	09/12/2006	Mark J. Field	PC26135A	9235

28523 7590 02/18/2009

PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

EXAMINER	
MAEWALL, SNIGDHA	
ART UNIT	PAPER NUMBER
1612	

NOTIFICATION DATE	DELIVERY MODE
02/18/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

~IPGSGro@pfizer.com

Office Action Summary	Application No.	Applicant(s)	
	10/598,712	FIELD ET AL.	
	Examiner	Art Unit	
	Snigdha Maewall	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7 and 12* is/are pending in the application.

4a) Of the above claim(s) *2-6 and 8-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/07/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Summary

1. Receipt of IDS filed on 10/07/08 is acknowledged.

Applicant's election without traverse of group 1 in the reply filed on 12/03/08 is acknowledged.

Applicant's election of specific ligand, antipsychotic and ziprasidone is also acknowledged.

Claim 1 has been amended, claims 2-6 and 8-11 have been cancelled. Claims **1, 7** and **12** are under prosecution.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Scope of Enablement

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the palliative treatment of pain, does not reasonably provide enablement for the curative or prophylactic treatment of pain. The specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The Applicant's attention is drawn to *In re Wands*, 8 USPQ2d 1400 (CAFC1988) at 1404 where the court set forth eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

(1) The nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

Nature of the invention: A pharmaceutical combination for the curative, prophylactic, or palliative treatment of pain comprising administering to a subject an a specific compound claimed in claim 1 in combination with ziprasidone.

The state of the prior art: The claimed compound is Alpha-2-delta ligand and an antipsychotic ziprasidone which possess multiple biological effects, not all of which have been fully characterized. Both the drugs used in the claimed invention are known to exert analgesic effects against pain, particularly neuropathic pain. These analgesic effects are temporary, and no permanent effects on the subject's nervous system have been reported. Drugs which exhibit a permanent curative analgesic effect (i.e. permanently relieving a painful syndrome) are not known, except in cases where the relief of pain is a secondary effect to the permanent cure of the underlying disease (e.g. pain caused by cancer or microbial infection). Similarly, there is no

precedent in the prior art for any alpha-2-delta ligand, antipsychotic, combination thereof, or compound possessing similar biological activity, which is capable of permanently preventing the occurrence of pain after the drug is cleared from the patient's system. Similarly, no drug could permanently prevent the occurrence of all pathological conditions having neuropathic pain as a symptom, as many of these conditions (e.g. postsurgical pain, phantom limb syndrome) arise from physical trauma to the nervous system and no drug is capable of preventing physical trauma.

In fact, no mechanism is known by which drugs of the kind described in the claimed invention could exert any analgesic effects after being cleared from a subject's system, as they must generally be present within the subject's body in order to be effective. Furthermore, it is generally desired within the art that an analgesic treatment not exert permanent effects on a patient's nervous system, as such permanent effects may very well be deleterious.

The relative skill of those in the art: The relative skill of those in the art is high.

The predictability or unpredictability of the art: There are many different syndromes which may lead to neuropathic pain as one symptom. According to the Merck Manual of Diagnosis and Therapy, 17th edition (Reference included with PTO-892) neuropathic pain may be caused by multiple underlying causes, generally classified as either deafferentiation pain or sympathetically maintained pain. (p. 1371, right column, third paragraph) Specific syndromes causing neuropathic pain include, but are not limited to postherpetic neuralgia, phantom limb pain, root avulsions, painful traumatic neuropathy, painful polyneuropathy, central pain

syndromes, postsurgical pain syndromes, and postthoractomy syndrome. (p. 1372, left column, 4th paragraph) Furthermore, it is stated that, "Treatment applied without concern for diagnosis, rehabilitation, and psychosocial issues has a limited chance of success." (p. 1372, left column, 3rd paragraph) Thus a treatment that is prophylactic or curative for one particular neuropathic pain syndrome is unlikely to thus be curative for every neuropathic pain syndrome, as a cure or prevention would involve the permanent reversal or prevention of the underlying syndrome rather than the temporary relief of painful symptoms.

The Breadth of the claims: The combination and methods for the manufacture of a medicament of the instant claims are directed to a pharmaceutical composition for the curative, prophylactic, or palliative treatment of pain, particularly neuropathic pain. Curative treatment is interpreted to mean treatment that causes the complete and permanent remission of a condition involving pain. Prophylactic treatment is interpreted to indicate treatment that, when administered before the occurrence of pain, prevents the pain form developing at any point in the future. Palliative treatment is interpreted to indicate a treatment which, when administered to a patient suffering from pain, causes the temporary reduction or disappearance of the pain. Unlike curative or prophylactic treatment, palliative treatment need not be permanent or complete to be considered effective. Repeated administration of a palliative treatment for the duration of a subject's lifespan in order to suppress the symptoms of a disorder is not considered to constitute a curative treatment.

The amount of direction or guidance presented: Protocols for using the claimed combinations to permanently prevent or cure painful syndromes are not given.

The presence or absence of working examples: No working examples are given for the treatment of pain in any manner.

Note that lack of working examples is a critical factor to be considered, especially in a case involving an unpredictable and undeveloped art such as the permanent relief of neuropathic pain. See MPEP 2164.

The quantity of experimentation necessary: Based on the state of the prior art, one skilled in the art would believe that the only way to permanently cure a case of neuropathic pain is to remove the underlying cause. Similarly, the only way to permanently prevent neuropathic pain is to permanently prevent every disorder having neuropathic pain as a symptom. A cure is possible in certain instances, such as surgical decompression of carpal tunnel syndrome. Other forms of neuropathic pain, such as that arising from phantom limb syndrome, cannot be permanently cured or prevented and must be treated through palliative means. The applicant's disclosure does nothing to challenge this conclusion. Although the applicant discloses a pharmaceutical composition which is potentially useful for the palliative treatment of neuropathic pain, nothing in the disclosure suggests that there exists any method by which the claimed composition would be useful for the curative or prophylactic treatment of neuropathic pain.

In order to practice the claimed invention for the curative or prophylactic treatment of neuropathic pain, one skilled in the art would need to independently develop curative and preventative therapies for a variety of disorders, including but not limited to those recited previously. It is unlikely that every such syndrome would be adequately cured or prevented by a pharmaceutical treatment. Rather, certain treatments would involve surgery and/or physical therapy as an essential component for the cure or prevention of neuropathic pain. Developing such therapeutic methods in the absence of any guidance from applicant's disclosure constitutes undue experimentation. Thus the applicant's disclosure is not enabling for the curative or prophylactic treatment of pain, particularly neuropathic pain.

Genetech, 108 F.3d at 1366, sates that, "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion." And "patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable."

Therefore, in view of the Wands factors, as discussed above, particularly the unpredictability of the art and the lack of guidance or working examples, Applicants fail to provide information sufficient to practice the claimed invention for the curative or prophylactic treatment of neuropathic pain.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

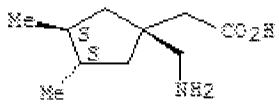
5. Claims 1, 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over David et al. (WO 2004054564) in view of Bradley et al. (US Pg pub. 20050096327) and Javitt et al. (US PG pub 20020183390).

David et al. disclose the claimed compound for treating neuropathic pain comprising the claimed compound.

AB This invention discloses the method for treating fibromyalgia and other disorders in a mammal, including a human, comprising administration of a therapeutically effective amount of a compds. of Formula I or Formula II (where R1 - R14 = H, (un)branched C1-C6 alkyl, ph, OH, etc., and R1 - R8 are not simultaneously H) or a pharmaceutically acceptable salt thereof.

RN 223445-67-8 HCAPLUS
CN Cyclopentaneacetic acid, 1-(aminomethyl)-3,4-dimethyl-, hydrochloride (1:2), (3S,4S)- (CA INDEX NAME)

Absolute stereochemistry. Rotation (+).



● HCl

The reference does not disclose antipsychotic in combination. Bradely discloses a combination of alpha- 2-delta ligands with antipsychotic agents.

The reference discloses that the novel compounds of this invention can be used in conjunction with one or more other antidepressants or anti-anxiety agents. Examples of classes of antidepressants that can be used in combination with the active compounds of this invention include norepinephrine reuptake inhibitors, selective serotonin reuptake inhibitors (SRIs), NK-1 receptor antagonists, monoamine oxidase inhibitors (MAOIs), reversible inhibitors of monoamine oxidase (RIMAs), serotonin and noradrenaline reuptake inhibitors (SNRIs), corticotropin releasing factor (CRF) antagonists, .alpha.-adrenoreceptor antagonists, **alpha-2-delta** ligands (A2D), and atypical antidepressants.[0284].

Suitable antipsychotic agents include both conventional and atypical antipsychotics. [0286]

The references together do not disclose Ziprasidone.

Javitt et al. disclose Ziprasidone for treating schizophrenia ,a neurological disorder.

It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to incorporate antipsychotic in the teachings of primary reference because secondary reference teaches the alpha 2-delta can be used in conjugation with antipsychotic. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to incorporate antipsychotic such as ziprasidone because ziprasidone helps in neurological disorders.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Snigdha Maewall whose telephone number is (571)-

272-6197. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0580.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Snigdha Maewall/

Examiner, Art Unit 1612

/Gollamudi S Kishore /

Primary Examiner, Art Unit 1612